

Application No. 09/994,526
Preliminary Amendment dated February 16, 2004
Reply to Office Action of October 16, 2003

AMENDMENTS TO THE DRAWINGS:

The attached sheet of drawings includes Figs. 3a, 3b and 3c. This sheet, which includes Figs. 3a, 3b and 3c, replaces the original sheet including Figs. 3a, 3b and 3c.

Attachment: Replacement Sheet

REMARKS

Claims 1-7 were pending in the application; however, by this Amendment claim 7, which is directed to a non-elected invention, as well as claims 1 and 2, have been cancelled without prejudice, and new claims 8-10 have been added to provide a more adequate basis for protection of the invention. Thus, upon entry of this Amendment, claims 3-6 and 8-10 will be pending.

Also by this Amendment claims 3 and 4 have been amended to more particularly point out and distinctly claim the invention.

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicants respectfully request receipt of this document when it becomes available.

The indication, in the Advisory Action dated February 6, 2004, that the Examiner has approved the Request for Approval of Proposed Drawing Change filed on November 27, 2001, is noted with appreciation. The revised formal drawing for Figs. 3a, 3b and 3c is being filed concurrently herewith.

35 U.S.C. § 102(b) Rejection

Claims 3 and 4 presently stand rejected under 35 U.S.C. § 102(b) over Holka (U.S. Patent No. 5,082,077). Because Holka fails to disclose all of the limitations of claims 3 and 4 as amended, it is respectfully submitted that claims 3 and 4 patentably distinguish over Holka.

Specifically, respect to claim 3 (and claim 4, which depends from claim 3), this claim as amended recites:

A hollow rack shaft formed of one plate workpiece for a steering system,

wherein said workpiece has opposing edges and extends in a longitudinal direction,

wherein said workpiece is formed into a hollow tube about an axis of said shaft, the axis extending in the longitudinal direction,

wherein the opposing edges are butted together to form a butted portion,

wherein the butted portion includes a first section thereof that extends in said longitudinal direction and includes a second section thereof that extends in a direction non-parallel to the longitudinal direction, and

wherein two rack teeth groups are respectively formed by plastic working and are located longitudinally apart from each other.

Holka discloses a steering system that includes a rack member having a plurality of rack gear teeth. However, Holka fails to disclose several aspects of claim 3. For example, Holka fails to disclose that the rack member is hollow, has opposing edges butted together to form a butted portion, and that the butted portion has sections offset by an angle. Thus, since Holka fails to disclose all of the limitations of claim 3, Holka cannot anticipate claim 3, or claim 4 which depends from claim 3.

Accordingly, it is respectfully requested that the rejection of claims 3 and 4 under 35 U.S.C. § 102(b) over Holka be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejection

Claims 5 and 6 presently stand rejected under 35 U.S.C. § 103(a) over Holka in view of Anderson (U.S. Patent No. 4,741,191). Because Holka and Anderson do not disclose or suggest all of the limitations of claims 5 and 6, it is respectfully submitted that claims 5 and 6 patentably distinguish over the proposed combination of Holka and Anderson.

Specifically, claims 5 and 6 depend from claim 3, presented above as amended.

The proposed combination of Holka and Anderson fails to disclose or suggest several aspects of amended claim 3. For example, both Holka and Anderson, alone or in

Application No. 09/994,526
Preliminary Amendment dated February 16, 2004
Reply to Office Action of October 16, 2003

combination, fail to disclose or suggest a hollow rack shaft having opposing edges butted together to form a butted portion wherein the butted portion has sections offset by an angle. Thus, since the proposed combination of Holka and Anderson fails to disclose or suggest all of the limitations of claim 3, the proposed combination of Holka and Anderson cannot render obvious claim 3, or claims 5 and 6 which depend from claim 3.

Accordingly, it is respectfully requested that the rejection of claims 5 and 6 under 35 U.S.C. § 103(a) over Holka in view of Anderson be reconsidered and withdrawn.

New Claims

New claims 8-10 have been added to provide a more adequate basis for protection of the invention. No new matter has been added. Claims 8-10 indirectly depend from claim 3. Thus, claims 8-10 are considered patentably distinguishable over the cited references for at least the same reasons discussed above in connection with claim 3.

CONCLUSION

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Preliminary Amendment does not increase the number of independent claims, does not increase the total number of claims beyond twenty, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be

Application No. 09/994,526
Preliminary Amendment dated February 16, 2004
Reply to Office Action of October 16, 2003

construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any fee required for such Petition for Extension of Time, and any other fee required by this document, other than the issue fee, and not submitted herewith, should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By:



Tung T. Nguyen
Registration No. 42,935
Attorney for Applicants

BEH/llb:bar/TTN/llb
SIDLEY AUSTIN BROWN & WOOD LLP
717 N. Harwood, Suite 3400
Dallas, Texas 75201
Direct: (214) 981-3478
Main: (214) 981-3300
Facsimile: (214) 981-3400
February 16, 2004

DAI 285237vl